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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,051	06/29/2005	Philip Steven Newton	NL 021482	4083
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EXAMINER				
NEWLIN, TIMOTHY R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,051

Applicant(s)

NEWTON ET AL.

Examiner

Timothy R. Newlin

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/12/2009 has been entered.

Response to Arguments

As stated in the advisory action dated 7/1/2009, the language added to the preamble changes the claim so that

the method relates specifically to storage rather than playback. However, the added language [does] not distinguish over OPENTV as stated on page 2 of the final rejection [dated 4/23/2009], which cites p. 5, ll. 26-27 of OPENTV to meet the storage component. The amendment also adds the word "alternatively" to the last limitation. The alternative nature of the categories is implicit even without the recital of "alternatively," by virtue of the "or" structure of the last limitation. The...addition of "alternatively" does not substantively change the scope of the claim...

Therefore, neither the storage limitation nor the alternative language distinguishes the

claim over OPENTV. Likewise, the other amended language does not overcome OPENTV and is met with citations in the rejections below.

With respect to the arguments presented, they have been fully considered but they are not persuasive.

First, Applicant argues that OPENTV does not teach indicating whether a particular data object is needed. However, OPENTV states that flags may be used to indicate particular data that *need* to be cached by the receiver [p. 5, ll. 25-26]. In the Examiner's opinion, this meets the recited language of a mandatory category. Applicant also appears to argue that even the claimed functionality is present in OPENTV, it is only in connection with playing a program as opposed to storing it. Examiner disagrees. OPENTV states that object properties (including flags to indicate necessary modules) can be used by the receiver in storing or replaying the data objects p. 5, ll. 26-27]. It is also noted that a broad construction of the claimed "modules" would encompass both "data objects" and files. Therefore whether the data objects are stored in sets of files is not dispositive.

Next the Applicant asserts that OPENTV does not transmit storage related information indicating the alternative statuses. Examiner disagrees.

With respect to the "optional for recording" status, Examiner notes that "optional" is an extremely broad term that does not imply and specific decision tree or protocol for choosing among optional data modules; it merely implies that a data module is not required to be saved nor is it prohibited from being saved. In that sense it is a negative limitation, covering data modules that are anything but required or prohibited.

Accordingly, OPENTV, which allows a user to choose certain modules at will (e.g. "if a user wishes to record", "user initiates recording") meets the limitation. [p. 6, l. 38; p. 8, ll. 26-27].

Applicant also disputes the citation of OPENTV used to meet the recited category stating that a module is forbidden to record. "Forbidden" as recited is construed to mean any module that is prevented from being recorded. OPENTV describes a system whereby carousels comprising data object are given a temporal validity range. Outside that validity range, the data objects are unavailable or invalid [p. 8, ll. 5-7]. In other words, some data objects, as designated by a temporal validity range, may not be recorded, i.e. are forbidden to record. Thus the recited language is met by OPENTV.

The Applicant also explains some purported differences between OPENTV and the claimed invention. Applicant characterizes OPENTV as restricting availability of data modules to specific receivers, while the claimed invention categorizes data modules for the benefit of any receiver having a recording capability. While the object of the present invention is understood, the claims do not reflect any patentable distinction over OPENTV. It is not clear to the Examiner that the claimed difference would be patentably significant. In any event, the distinction between categorizing data modules for any receiver, and doing so for only selected receivers, is not reflected in the claim language itself and is therefore ineffective to distinguish over OPENTV.

For the reasons explained above, the rejections stand.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1, 4-6, and 9-16 are rejected under 35 U.S.C. 102(a) as anticipated by OPENTV, WO 01/33852.
2. Regarding claim 1, OPENTV discloses a method and use of transmitting interactive television, whereby at least an interactive television application is transmitted inside application-modules in a broadcast stream that includes television content, wherein said method facilitates recording [p. 5, ll. 26-27] of said broadcast stream at a receiver, said method comprising the step of
Including storage related information for each of said modules in a transmitted broadcast stream [p. 4, 32-35; p. 5, 26-27, pp. 6-7, lines 37-5]; and
characterized in that said storage related information comprises categories indicating whether each said module is alternatively mandatory for recording [if **program is to be played immediately, the data objects are deemed necessary, p. 4, 31-32; flags are inserted identifying objects that need to be cached, p. 5, line 25-26**], optional for recording [programs can be stored at the option of the user, p.

6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7], or forbidden [live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7] to be recorded at the receiver.

3. Regarding claim 4, OPENTV discloses a method according wherein said storage related information further comprises module identification information **[p. 5, line 15; p. 7, 24-28].**

4. Regarding claim 5, OPENTV discloses a method wherein the step of including storage related information comprises including said storage related information in an Application Information Table **[file table, p. 3, 5-19]** and/or in a Download Information Indication message.

5. Regarding claims 6 and 12, OPENTV discloses a method whereby said module identification information is defined and included in the AIT and consists of two fields, the first field being an organisation_id **[e.g., version number or carousel ID, p. 5, 13-16]** and the second field being an application_id **[object identifiers are transmitted, p. 2, line 35]**, whereby said id values are used to identify identical applications **[version numbers are used by the receiver to identify identical versions, for example to filter incoming data objects, p. 5, 24-28].**

6. Regarding claim 9, OPENTV discloses a method whereby said signaling storage related information comprises signaling of properties of a module chosen from code and/or data [p. 5, 29-30].

7. Regarding claims 10 and 11, OPENTV discloses a method of receiving an interactive television broadcast stream for recording, whereby at least an interactive television application is comprised in the broadcast stream inside application-modules , said method comprising the steps of

extracting storage related information for each of said modules from said broadcast stream [p. 5, 12-18], and

recording modules which are mandatory or optional for recording, based on said storage related information [**flags indicate data objects that need to be recorded, p. 5, 24-28**];

characterized in that said storage related information comprises categories indicating whether said modules are alternatively mandatory for recording [**if program is to be played immediately, the data objects are deemed necessary, p. 4, 31-32; flags are inserted identifying objects that need to be cached, p. 5, line 25-26**], optional for recording [**programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7**], or forbidden [**live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7**] to be recorded.

8. Regarding claim 13, OPENTV discloses a method whereby said interactive television is MHP, OpenTV or DASE **[Summary section describes OPEN protocol. pp. 2-3]**.

9. With respect to claim 14, OPENTV discloses an apparatus for recording and/or playing back interactive television, said apparatus being adapted to record and/or playback an interactive television broadcast stream to and from a storage medium respectively, said apparatus being adapted to receive said interactive television broadcast stream, said broadcast stream including television content, an interactive television application contained in modules, and storage related information for each of said modules, said apparatus comprising

means for extracting storage related information of said modules from said broadcast stream **[p. 5, 12-18]**, and

means for recording modules in dependence on said storage related information, **[receiving station 18 and mass storage device 16, Fig. 1]**

characterized in that said storage related information comprises categories indicating whether said modules are alternatively mandatory for recording **[if program is to be played immediately, the data objects are deemed necessary, p. 4, 31-32; flags are inserted identifying objects that need to be cached, p. 5, line 25-26]**, optional for recording **[programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7]**, or forbidden **[live data objects are not stored, p. 3, line 20; objects categorized as**

outside their validity range are unavailable for storage, p. 8, 5-7] to be recorded, and said means for recording being adapted to record only modules for which said storage related information allows recording.

10. Regarding claim 15, OPENTV discloses an apparatus whereby said storage related information comprises module identification information for modules, and whereby said apparatus further comprises means for preventing recording of more than one application module with identical module identification information on a storage medium in said apparatus **[version numbers are used by the receiver to identify identical versions, for example to filter incoming data objects, p. 5, 24-28]**.

11. Regarding claim 16, OPENTV discloses a computer-readable medium having embodied thereon a computer program for processing by a computer, said computer program causing said computer to prepare and transmit an interactive television broadcast stream facilitating recording by a receiver, the computer program comprising
a code segment for causing the computer to include application modules and storage related information for each of the application modules in an interactive television broadcast stream, at least an interactive television application being included inside said application modules **[broadcast station 12 and application execution engine perform the method disclosed in OPENTV, see Summary, pp.2-3; p. 4, 11-35]**;

a code segment for causing the computer to transmit the interactive television broadcast stream [p. 4, ll. 26-29; p. 4, 11-35],

characterized in that said storage related information comprises categories indicating whether said modules are alternatively mandatory for recording **[if program is to be played immediately, the data objects are deemed necessary, p. 4, 31-32; flags are inserted identifying objects that need to be cached, p. 5, line 25-26],** optional for recording **[programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7],** or forbidden **[live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7]** to be recorded.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPENTV as cited above, in view of Metz et al., US 5,678,539.
13. Regarding claim 2, OPENTV does not disclose using DSMCC modules to transmit application data. Metz teaches this method at **col. 10, 5-12].** One of ordinary

skill would have been motivated to format the data modules disclosed in OPENTV for transmission via DSMCC protocol, in order to provide a standard data format usable by a wide range of receivers. Metz articulates the need for a standard interface protocol **[col. 4, 53-64]**. Using DSMCC provides a standard protocol that can be used across different receiver platforms.

14. Regarding claim 3, OPENTV discloses a method wherein said at least one application object comprises at least one application file object and at least one application directory object, said application file object comprising at least one application file and said at least one application directory object comprising storage directory information on respective application file **[p. 3, 5-6; p. 5, 14-16]**.

15. Regarding claim 8, OPENTV discloses a system that generates groups of modules with similar storage related information in an object carousel for broadcasting **[carousels are groups of data objects that are transmitted together, with corresponding version numbers and carousel references, pp. 7-8, lines 26-2; p. 8, lines 22-28]**. As discussed above, Metz teaches the use of DSMCC protocol.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy R. Newlin whose telephone number is (571) 270-3015. The examiner can normally be reached on M-F, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TRN